

Appl. No. : 10/635,773

Amendment Dated April 11, 2006

FILED VIA FAX. (571) 273-8300

Response to Office Action Mailed February 9, 2006

**REMARKS****A. GENERALLY**

Claims 1-57 remain in this application. Claims 1, 9, 16, 23, 35, 37, 39 and 46 have been amended. No new matter has been added.

Applicant wishes to thank the examiner for extending the courtesy of an interview on April 4, 2006. As noted in the Interview Summary prepared by the examiner, no agreement was reached on the claims. Applicant has, therefore, filed this response to the Office Action of February 9, 2006.

**B. CLAIM REJECTIONS**

## Claim Rejections under 35 U.S.C. 102(e)

1. Claims 1, 9, 16, 23, 20, 35, 37, 39 and 46-47 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application 2001/0019422 filed by Hara (herein, "Hara").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP §2131, 8th Ed. (Rev. 3, 2005).)

The claims of the present invention are directed to a system and method for incorporating customized content into a booklet. A content control identifier is read from a pre-printed custom booklet component and sent to a content controller. The content controller uses the content control identifier to obtain instructions from a datastore and uses the instructions to create one or more "just-printed" custom booklet components and marry them to pre-printed custom booklet component to create a customized booklet. Alternatively, a generic booklet body is printed on a web-fed press. A content control identifier is read from a pre-printed custom booklet component and sent to a content controller. The content control identifier is used to trigger the personalization (for example, the addressing) of the generic output for a targeted recipient and to marry the preprinted signature from which the content control identifier was read to the personalized web-fed press output to form a customized booklet for the targeted recipient. The written description further supports the customized-individualized nature of the catalogs printed.

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In contrast to the claims of the present application, Hara is directed to a network-based system for printing photographs ("prints") at laboratories. According to the application, when a large amount of orders from users are received by the customer service system, the laboratory also has the large amount of orders. Therefore, a load of the laboratory becomes large, since a large amount of prints need to be generated at once. Furthermore, a load of the customer service system is also large, since the system needs to deal with the large amount of orders. Hara solves this problem by describing a method for directing an order for a print to a particular lab.

The process for directing a print is described as follows:

[0075] The customer service systems 3A.about.3C are Web sites on the network 2 for receiving the order information C from the user. The customer service systems are sites having users as members, such as a site for carrying out a mail-order service, a site providing various kinds of information services to the users, and a site of an Internet provider the users use. The customer service systems are not limited to the above examples. The user accesses a desired one of the customer service systems 3A.about.3C by using a Web browser installed in the personal computer 1, and transfers the order information C and the image data S to the desired customer service system. The customer service system desired by the user receives the order information C and the image data S, and generates flow information R transferred together with the information and the data to the order assigning system 4. The flow information R is information the order assigning system 4 refers to upon assigning the order to one of the laboratories, which will be explained later. More specifically, the flow information can be a code number indicating a logistic base of the customer service system, the name of the laboratory from which the printing is requested, or an address of the user. In this embodiment, the customer service systems 3A.about.3C respectively use the code number, the laboratory name, and the user address as the flow information R.

The Hara specification does not refer to a book, a booklet, a pamphlet, or a document. Hara does not refer to "assembling" or "combining" or "marrying" printed materials to form a larger document. Hara uses an identifier to route a print order to a print laboratory. Hara does not teach using an identifier to obtain instructions and using the instructions to create a just-printed custom booklet component and to marry the pre-printed custom booklet component and the just-printed custom booklet component to produce a customized booklet for the targeted recipient.

Applicant respectfully submits that Hara does not anticipate claim 1, 9, 16, 23, 30, 35, 37, 39 and 46-47.

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## Claim Rejections under 35 U.S.C. 103(a)

2. Claims 2-8, 10-15, 17-22, 24-34, 36, 38, 40-45 and 48-56 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Hara in view of Grady (US20010056463).

Grady, according to its inventors, is a document management system and method and does not result in printing a custom document selected for a particular recipient. Further, Grady is directed to managing documents in electronic form. Inherent in the Grady management system is that the documents are present as true copies of an original document. Thus, each member of the audience that accesses an electronic "Grady" document will receive the same version of the document associated with a code. A Grady document is not, therefore, customized nor is its specific content selected for a particular recipient.

The office action found that Hara and Grady are combinable because it was determined that the references describe the printing of booklets. However:

- There is nothing in Hara or Grady that can be interpreted as teaching or describing the printing of a booklet.
- Hara is directed solely to the printing of "prints," which may include postcards. Grady is directed to the conversion of documents to electronic form, not printing.
- The references are non-analogous art as to each other and as to the present application.
- Not only are the two references not prior art as to the present invention, there is no motivation to combine these references. The combination would not perform the limitations of the present application and would certainly change the theory of operation of the primary reference (Hara).

Claim 2 recites the limitation, "The booklet system of claim 1, wherein the content control identifier is a machine-readable code." Claims 10, 17, 24, 40 and 47 also identify the content control identifier as a machine-readable code (MRC). In rejecting these claims, the examiner suggests that a "machine readable code" described in Grady could be combined with Hara to provide a user with a simple code that could be read by a scanner. However:

- Hara does not disclose a function performed by the user for which an MRC would be advantageous.
- The code in Hara is assigned by the order assigning system and making it an MRC serves no obvious purpose, nor did the examiner suggest one.
- The MRC in Grady does not relate to a content control identifier as that term is used in the base claim.

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- The cited text of Grady describes a physical printed document 18 that comprises a code 20. The document described by Grady is perused by a user. If the user determines that document is useful, the user enters the code from the document into a client computer 12 and retrieves a document. The document is not pre-printed custom booklet component.

Claim 3 recites the limitation, "The booklet system of claim 1, wherein the system further comprises a feeder/scanner adapted to receive the pre-printed custom booklet component, to read the content control identifier, and to send the content control identifier to the content controller." Claims 3, 11, 18, 25, and 48 also recite a feeder/scanner adapted to receive the pre-printed custom booklet component (among other functions). In rejecting these claims, the examiner found that Grady disclosed a feeder/scanner adapted to receive the pre-printed custom booklet component.

[0042] Additionally, in the case that the identification code 20 is a machine-readable code, such as a barcode, or other similarly encoded object, a user may utilize a scanner, or other similar technology to read the code. Devices such as personal digital assistants (PDAs), mobile telephones, or other portable computing devices able to scan images may also be used. In accordance with a specific embodiment of the present invention, a specialized code acquisition device, which may, for example, be shaped in the form of a pen, keyfob or other convenient form, may be used acquire the code.

Again, the examiner determined that both Grady and Hara could be combined. However:

- the feeder/scanner of Grady does not receive a pre-printed custom booklet component, but rather reads a code for acquiring an electronic version of a paper document;
- because neither Grady nor Hara discloses a content controller, Grady does not teach sending the content control identifier to the content controller.

Claim 4 recites the limitation, "The booklet system of claim 1, wherein the pre-printed custom booklet component comprises one or more signatures printed on a web-fed printer and customized for the targeted recipient and the just-printed custom booklet component comprises a cover printed on a sheet-fed printer." Claims 12, 19, 31 and 41 also recite the signature limitation. Note that "signature" is as defined in the application:

Signature - a sheet of paper printed on both sides that, when optionally folded and included in a document or booklet, constitutes a number of pages always divisible by 2 and typically 4 or some other power of 2. (Specification, ¶ 0038)

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In rejecting these claims, the examiner found that Grady disclosed that the pre-printed custom booklet component comprises one or more signatures and the just-printed custom booklet component comprises a cover printed on a sheet-feed printer:

[0102] Additionally, the present invention could be used to develop personal codes for individual users and/or that user's personal files. For example, a unique, personalized code could be assigned to each user. This code could be, for example, embodied in an image (e.g., a TIFF file, EPS file, etc.). This image could then be printed on a business card, or other physical medium, whereby a user could share it with other users. This image could also be managed within a user account window 162, uniquely identifying the user in the same manner as a PIN. When a user of the system scans another user's code, that user's information could be automatically added to an address book, or other similar contact organizational tool.

However:

- Nothing in the cited text describes a "signature" printed on a web-fed printer.
- Nothing in the cited text describes a cover printed on a sheet feeder.
- The examiner provides no rationale for combining Hara and Grady to include the elements of this limitation in Hara.
- There is no motivation for combining Grady with Hara.

Claim 5 recites the limitations, "The booklet system of claim 4, wherein the booklet system further comprises a pre-printed generic booklet component and wherein the content controller is further adapted to use the instructions to marry the pre-printed custom booklet component, the just-printed custom booklet component, and the pre-printed generic booklet component to produce a customized booklet for the targeted recipient." Claims 30, 32, 36, 38, 42, 53, and 55 also recite the generic book component. In rejecting these claims, the examiner found that Hara disclosed these limitations citing paragraphs 0079-0084 (emphasis added by underlining):

[0079] Operation of this embodiment will be explained next, FIG. 3 is a flow chart showing the operation. The user generates the order information C for placing the order, by using the personal computer 1 (Step S1). The user transfers the order information C and the image data S to any one of the customer service systems 3A.about.3C (Step S2). In this embodiment, the information and the data are assumed to have been transferred to the customer service system 3C. The customer service system 3C receives the order information C and the image data S, and generates the flow information R (Step S3). In this embodiment, the address of the user, "Kanagawa", is used as the flow information R. The order information C, the image data S and the flow information R are then transferred to the order assigning system 4 (Step S4).

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[0080] The order assigning system 4 receives the order information C, the image data S, and the flow information R, and refers to the database 5 (Step S5). Based on the flow information R, the order assigning system 4 selects one of the laboratories 6A.about.6C to carry out the printing (Step S6). In this embodiment, the user has requested printing from the customer service system 3C and the customer service system 3C has generated the flow information "Kanagawa". Therefore, the order assigning system 4 selects the laboratory 6C by referring to the table T shown in FIG. 2. The order assigning system 4 transfers the order information C and the image data S to the selected laboratory 6C (Step S7). Based on the order information C, the laboratory 6C outputs the image data S (Step S8), and the procedure ends.

[0081] As has been described above, in this embodiment, the order assigning system 4 selects one of the laboratories 6A.about.6C to carry out printing, based on the flow information R. The selected laboratory then carries out the printing. Therefore, even in the case where the customer service systems 3A.about.3C have a large amount of orders, each order can be assigned to any one of the laboratories 6A.about.6C, and the load of each laboratory can be reduced. Furthermore, since the three customer service systems are used, interfaces for order reception can be increased. In this manner, loads of the customer service systems 3A.about.3C can be reduced.

[0082] In the above embodiment, one of the laboratories 6A.about.6C to carry out the printing is selected based on the flow information R. However, one of the laboratories may be selected based on the content of the order described in the order information C. Assume that the laboratory 6A carries out printing of postcards and ordinary prints, while the laboratory 6B carries out printing of ordinary prints only. The laboratory 6C carries out printing of enlargements and ordinary prints. If the content of the order described in the order information C specifies a "postcard", the order assigning system 4 selects the laboratory 6A. If the content of the order in the order information C describes an "enlargement", the laboratory 6C is selected. If the content specifies an ordinary print, any one of the laboratories 6A.about.6C can be selected.

[0083] Furthermore, since the order information C generally has the address and the phone number of the user, the order assigning system 4 may select any one of the laboratories 6A.about.6C convenient for the user, based on the address and the area code of the phone number described in the order information C, without generating the flow information R.

[0084] In the above embodiment, the customer service system that received the order information C generates the flow information R, and the order assigning system 4 selects the laboratory to carry out the printing, based on the flow information R. However, without generation of the flow information R by the customer service system, the order assigning system 4 may select the laboratory to carry out the printing, based on a load of each of the laboratories 6A.about.6C. In this case, the database 5 has a table T0 indicating the load status of each of the laboratories 6A.about.6C as shown in FIG. 4, instead of the

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table T shown in FIG. 2. The table T0 shows, as the load status, the number of orders each of the laboratories is currently dealing with.

However:

- There is no reference in the cited text to a document, a booklet, or any other pre-printed object;
- There is no reference to combining any printed objected with another printed object; and
- There is no reference to the production of a customized booklet for a targeted recipient.

Claim 6 recites the limitations, "the booklet system of claim 5 wherein the content control identifier is associated with profile data of the targeted recipient and wherein the pre-printed generic booklet component is selected from a set of pre-printed generic booklet components for inclusion in the customized booklet using the profile data." Claims 13, 20, 28, 33, 43, 51, 54, and 56 also recite the profile limitation. In rejecting these claims, the examiner found that Hara disclosed these limitations citing paragraphs 0079-0084 (quoted above). However:

- There is no reference in the cited text to a document, a booklet, or any other pre-printed or generic object;
- There is no reference to selecting a pre-printed generic booklet component from other such objects;
- There is no reference to combining or including any printed objected with another printed object;
- There is no reference to the production of a customized booklet for a targeted recipient; and
- There is no reference to user data for any purpose other than selecting a print lab.

Claim 7 recites the limitations, "The booklet system of claim 6, wherein the profile data of the targeted recipient is selected from the group consisting of an address, a set of preferences, a set of demographic data, and a set of historical data." Claims 14, 21, 26, 27, 29, 44, 49-50, and 52 also recite these limitations. In rejecting these claims, the examiner found that Grady disclosed the list of profile data. However, the citation for support appears to be Hara, paragraphs 0079-0084 (quoted above). Hara only recites using an address and perhaps a preference to select a lab for printing a photographic image.

Claim 8 recites the limitations, "The booklet system of claim 1, wherein the booklet is selected from the group consisting of a book, a catalogue, a program, a service manual, a

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periodical, a report, a legal agreement, and a training manual." Claims 8, 15, 22, 34, 45, and 57 also recite these limitations. The examiner determined that Grady disclosed these limitations. However, the citation for support appears to be Hara, paragraphs 0079-0084 (quoted above). Neither Grady nor Hara teach or describe a customized booklet.

Based on the foregoing, Applicant submits that Claims 2-8, 10-15, 17-22, 24-34, 36, 38, 40-45 and 48-56 of the present invention as examined are patentable over Hara in view of Grady.

### C. CONCLUSION

In view of the above information and remarks, Applicant respectfully requests reconsideration of the current rejections. For the above reasons, Applicant respectfully submits that the application is in condition for allowance with claims 1-57. Should any further questions arise concerning this application or in the event the above amendments do not place the application in condition for allowance, Applicant respectfully requests an interview with the examiner and the examiner's supervisor prior to any new office action relating to the present Application. Attorney for the Applicant may be reached at the number listed below. The Director of the U.S. Patent & Trademark Office is authorized to charge any necessary fees, and conversely, deposit any credit balance, to Deposit Account No. 18-1579.

Respectfully Submitted,

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